

**Amendments to the Drawings:**

The attached replacement drawing sheet makes changes to Fig. 2 and replaces the original drawing sheet that shows Figs. 1 and 2.

Attachment: Replacement Drawing Sheet

**REMARKS**

Claims 1-41 are pending in this application. Claims 1, 9, 18, 26 and 37 are amended to recite that the filtering passages (third passage in claim 1, etc.) are formed by etching and thus exhibit structural characteristics consistent with etching. The Office Action withdraws claims 6-25 and 31-39 from consideration. Claims 40 and 41 are added. Support for new claims 40 and 41 can be found in at least paragraph [0011] and Fig. 1. In light of at least the following remarks, Applicant respectfully requests reconsideration and allowance of the pending claims.

The courtesies extended to Applicant's representatives by Examiner Menon at the interview held May 3 are appreciated. The reasons presented at the interview as warranting favorable action are incorporated into the remarks below and constitute Applicant's record of the interview.

**I. Election of Species Requirement**

In a telephone Restriction/Election Requirement, Examiner Menon indicated there were 9 species. Applicant provisionally elected by telephone, on March 22, 2006, the first species (corresponding to Figures 1-3) with traverse and indicated claims 1-8 and 26-37 read on this species with at least claim 1 being generic to all species.

The Office Action withdraws claims 6-25 and 31-39 from consideration. The Office Action is silent as to any reasons why restriction/election is proper. The Applicant hereby affirms the telephone election with traverse.

According to MPEP §803, there are two requirements that must be met before a proper Restriction can be made. These two requirements are: "the inventions must be independent ... or distinct as claimed; and there must be a serious burden on the Examiner if

restriction is not required . . . " (emphasis added). Applicant respectfully submits that the Office Action fails to establish both requirements set forth in MPEP §803.

As to the first requirement, the Office Action is silent as to any reasons why restriction/election is proper. Thus, Applicant respectfully submits that the requirements for the first prong remain unestablished.

As to the second requirement, Applicant notes, generally speaking, that the first species (Figures 1-3) is directed to the formation of three sets of passages in two layers; that the species of Figures 4-21 are generally directed to additional sets of passages, additional layers, or the formation of the passages in different layers; and that the species of Figures 22-23 are generally directed to additional structure in the same layers as previous species.

Looking to the current classifications of the references already of record, e.g. U.S. Patent No. 5,114,581 to Goldsmith et al. currently classified in U.S. classes 210 and 45, there appears to be no relevant subclasses which would apply to only a subset of the species. Thus, Applicant asserts that a search for the first species would encompass the same ground as that required for the other species and therefore Applicant asserts that the requirements for prong 2 have not been met.

It is therefore respectfully asserted that the search and examination of the entire application could be made without serious burden. MPEP §803 states that "if the search and examination of an entire application can be made, without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions" (Emphasis added).

As the same subclasses in the U.S. patent classification system appear relevant to all the species, a search for all the species would be of no greater burden than a search for only the first species. For at least these reasons, and in order to avoid unnecessary delay and

expense to Applicant and duplicative examination by the Patent Office, Applicant respectfully requests withdrawal of the election requirement.

**II. Drawings**

By this Amendment, Fig. 2 is amended to include reference character 140, instead of reference character 130, to refer to the upper substrate in agreement with the specification.

**III. Claim Rejections**

The Office Action rejects claims 1, 2, 4, 5, 26, 28 and 29 under 35 U.S.C. §102(b) as unpatentable over U.S. Patent No. 5,114,581 to Goldsmith et al. (hereinafter "Goldsmith").

Applicant respectfully traverses the rejection.

Goldsmith at least fails to disclose any passage formed by etching corresponding to the third and fifth passages of claims 1 and 26, respectively. Goldsmith discloses only thin microporous membrane 28 applied to the longitudinal walls 14. Thus, Goldsmith discloses a filter formed from the pores in microporous membrane 28, not by passages etched into monolith 10.

Product-by-process features are not taught by similar structure resulting from a different process when there are distinguishing characteristics. *In re Thorpe*, 777 F.2d 695 (Fed Cir. 1985) (citing *In re Fitzgerald*, 619 F.2d 67 (CCPA 1980); *In re Best*, 562 F.2d 1252 (CCPA 1977)). In the instant case, the pores of microporous membrane 28 (1) do not extend between the passageways, requiring the pores in the longitudinal walls 14 to complete the fluid connection (2) number in the thousands if not millions, (3) vary in cross-sectional shape and dimension, and (4) define irregular paths. In contrast, Applicant's third and fifth passages in claims 1 and 5, respectively, as a result of being etched, (1) extend between the first and second passages (claim 1) and the third and fourth passages (claim 26), (2) are of a predetermined number, (3) are of equal cross-sectional shape and dimension, and (4) define

predetermined paths. Thus, the structure resulting from the etched passages is not equivalent to the structure of the pores disclosed in Goldsmith.

As Goldsmith does not disclose the structure of claims 1 and 26, claims 1, 2, 4, 5, 26, 28 and 29 are patentable over Goldsmith. Applicant respectfully requests withdrawal of the rejection.

Claims 3, 27 and 30 are rejected under 35 U.S.C. §103(a) as unpatentable over Goldsmith. Applicant respectfully traverses the rejection.

This rejection is premised upon the presumption that Goldsmith discloses all the features of claims 1 and 26. Because, as discussed above, Goldsmith does not disclose all the features of claims 1 and 26, the rejection is improper. Applicant respectfully requests withdrawal of the rejection.

#### **IV. New Claims**

New claims 40 and 41 have been added. Applicants submit that claims 40 and 41 read on the elected species. Applicants further submit that claims 40 and 41 are patentable over Goldsmith as Goldsmith discloses only pores of the microporous membrane 28 which are irregular in path. Applicants note that etched, fluidically parallel passages are not taught or obvious over the irregular pores of Goldsmith.

#### **V. Conclusion**

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-41 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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Attachments:

Replacement Sheet  
Amendment Transmittal

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